REMARKS

Entry of this response and reconsideration and allowance of the above-identified patent application are respectfully requested. Claims 1-23 were rejected in the office action. Claims 1, 5, 13 and 22 have been amended. Claim 4 has been canceled. No claims have been added. Therefore, following entry of the present response, claims 1-23 will remain pending in the present application.

This application claims priority under 35 U.S.C. § 119(e) from provisional application no. 60/171,519, filed December 22, 1999. Examiner is respectfully requested to acknowledge priority under 35 U.S.C. § 119(e) in the next communication.

Claims 1, 2 and 6-23 stand rejected under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 6,104,828 to Shioiri ("Shioiri"). Also, claims 3-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shioiri in view of U.S. Patent No. 6,084,598 to Chekerylla ("Chekerylla").

Independent claim 1 has been amended to recite the feature previously recited in now-canceled claim 4 (*i.e.*, processing by warping the digital images). Similarly, independent claims 13 and 22 have been amended to incorporate the same features. Accordingly, applicants respectfully request withdrawal of the rejection of claims 1, 2 and 6-23 under 35 U.S.C. § 102(e) over Shioiri.

Claims 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shioiri in view of Chekerylla. Specifically, the office action suggests that "Shioiri shows all of the claimed features except for deforming the digital images or warping the images." (*Office Action dated September 14, 2005* at p. 3). However, the office action suggests that Shiori's absent teaching is satisfied by Chekerylla which "teaches modifying digital images by using a

warping or deforming process to better display the human form." (*Office Action dated September 14, 2005* at p. 3). In making this combination, the office action suggests that "one of ordinary skill in the art would have found it obvious to combine the warping or deforming teaching of Chekerylla for the digital images obtained in the Shioiri device because it is known that ***the eye of a patient has the tendency to move and the warping taught by Chekerylla compensates for such small amounts of patient motion***." (*Office Action dated September 14, 2005* at p. 3) (emphasis added). With all due respect to the contentions in the office action, applicants respectfully disagree.

Because Shioiri does not teach the use of warping to manipulate the digital image, the office action combines Chekerylla. However, Chekerylla is nothing more than a reference to using warping techniques to process a digital image. The office action acknowledges that Chekerylla does not also teach processing of a digital image of an eye. Therefore, followed to its logical conclusion, the rationale in the office action would obviate manipulating an image of an eye using ***any*** type of processing. This simply is not permissible, unless either reference offers some teaching, or even a hint of such a combination. That hint is not provided by either Chekerylla or Shioiri.

The office action suggests that such a hint or teaching is provided because one of ordinary skill in the art would know that "***the eye of a patient has the tendency to move and the warping taught by Chekerylla compensates for such small amounts of patient motion.***" (*Office Action dated September 14, 2005* at p. 3) (emphasis added). This assertion is incorrect for at least two reasons.

First, movement of the eye has nothing to do with the presently claimed embodiment. As noted throughout the present specification and recited in the claims, the claimed

embodiments provide a technique for comparing distinct images of the eye, perhaps taken at various intervals in a patient's lifetime, even perhaps using different equipment. By processing the image, the embodiment permits subsequent comparison of the eye regardless of the different circumstances of each image, for example different magnification and perspective. "Movement of the eye" over the course of a single examination, simply cannot be asserted as a motivation for the presently claimed embodiments.

Second, movement of the eye does not provide a motivation to combine Shioiri and Chekerylla for the purpose of warping digital images of an eye. One skilled in the art of eye imaging would understand that the requirement of warping an image such that it can be compared with another image typically involves images that are taken over time, for example at various intervals in a patient's lifetime. Also, such warping may be necessitated by images taken using different equipment. However, images of an eye taken during the same session by the same equipment typically do not require processing as complex as warping.

Therefore, there is no motivation expressed in either Shioiri or Chekerylla to combine to meet the presently claimed embodiments. As such, the office action's assertion of obviousness amounts to nothing more than impermissible hindsight using the applicants' own invention. While assuming that impermissible hindsight reconstruction may lead to such a construction, 35 U.S.C. § 103 requires a higher standard. 35 U.S.C. § 103 requires a specific suggestion or motivation suggested in the prior art to modify the reference or to combine reference teachings. *MPEP 2143.*

Specifically, 35 U.S.C. § 103 requires a specific suggestion or motivation suggested in the prior art to modify the reference. *MPEP 2143.* "The prior art must provide a motivation or reason for the worker in the art, without the benefit of [applicants']

specification, to make the necessary changes in the reference device." M.P.E.P. § 2144.04 (*citing Ex parte Chicago Rawhide Manufacturing Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added). To establish a *prima facie* case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicants." *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). In other words, the mere fact that a reference ***can be*** modified does not render the resultant modification obvious unless the prior art also ***suggests the desirability*** of the combination. *M.P.E.P. § 2143.*

The office action, however, fails to explain where or even if the quoted statements of motivation are suggested by the cited references. The office action admits that Chekerylla does not provide specific guidance that would lead one of ordinary skill in the art to obtain the presently claimed embodiments. Moreover, the office action does not point to any evidence that would lead one of ordinary skill in the art to find obviousness. Therefore, should the Examiner choose to maintain this rejection, applicants respectfully request an explicit citation as to where it is suggested in the prior art.

Accordingly, applicants respectfully request withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) over Shioiri in view of Chekerylla.

CONCLUSION

In view of the foregoing, applicants respectfully submit that the claims are allowable and that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

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